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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/469,637 12/22/99 MOSES M CMZ-083CPCN

<input type="checkbox"/>	HM12/1121	<input type="checkbox"/>	EXAMINER
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GITOMER, R

ART UNIT 1623

PAPER NUMBER 8  
DATE MAILED: 11/21/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

<b>Office Action Summary</b>	Application No. <b>09/469,637</b>	Applicant(s) <b>Moses et al.</b>
	Examiner <b>Ralph Gitomer</b>	Group Art Unit <b>1623</b>
		
<p><input checked="" type="checkbox"/> Responsive to communication(s) filed on <u>Dec 22, 1999</u>.</p> <p><input type="checkbox"/> This action is <b>FINAL</b>.</p> <p><input type="checkbox"/> Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i>, 1935 C.D. 11; 453 O.G. 213.</p> <p>A shortened statutory period for response to this action is set to expire <u>1</u> month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).</p> <p><b>Disposition of Claims</b></p> <p><input checked="" type="checkbox"/> Claim(s) <u>1-121</u> is/are pending in the application.</p> <p>Of the above, claim(s) _____ is/are withdrawn from consideration.</p> <p><input type="checkbox"/> Claim(s) _____ is/are allowed.</p> <p><input type="checkbox"/> Claim(s) _____ is/are rejected.</p> <p><input type="checkbox"/> Claim(s) _____ is/are objected to.</p> <p><input checked="" type="checkbox"/> Claims <u>1-121</u> are subject to restriction or election requirement.</p> <p><b>Application Papers</b></p> <p><input type="checkbox"/> See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.</p> <p><input type="checkbox"/> The drawing(s) filed on _____ is/are objected to by the Examiner.</p> <p><input type="checkbox"/> The proposed drawing correction, filed on _____ is <input type="checkbox"/> approved <input type="checkbox"/> disapproved.</p> <p><input type="checkbox"/> The specification is objected to by the Examiner.</p> <p><input type="checkbox"/> The oath or declaration is objected to by the Examiner.</p> <p><b>Priority under 35 U.S.C. § 119</b></p> <p><input type="checkbox"/> Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).</p> <p><input type="checkbox"/> All <input type="checkbox"/> Some* <input type="checkbox"/> None of the CERTIFIED copies of the priority documents have been received.</p> <p><input type="checkbox"/> received in Application No. (Series Code/Serial Number) _____.</p> <p><input type="checkbox"/> received in this national stage application from the International Bureau (PCT Rule 17.2(a)).</p> <p>*Certified copies not received: _____.</p> <p><input type="checkbox"/> Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).</p> <p><b>Attachment(s)</b></p> <p><input type="checkbox"/> Notice of References Cited, PTO-892</p> <p><input type="checkbox"/> Information Disclosure Statement(s), PTO-1449, Paper No(s). _____</p> <p><input type="checkbox"/> Interview Summary, PTO-413</p> <p><input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review, PTO-948</p> <p><input type="checkbox"/> Notice of Informal Patent Application, PTO-152</p>		

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- 5           I. Claims 1-34, 47, 48, 50-55, 64-103, drawn to a method for facilitating a diagnosis, classified in class 435, subclass 6.
- II. Claims 35-46, 49, 104-114, drawn to a method for facilitating the prognosis of prostate disorders, classified in class 435, subclass 6.
- 10          III. Claims 56-63, 115-121, drawn to a kit for facilitating diagnosis, classified in class 435, subclass 975.

The inventions are distinct, each from the other because:

15          Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as being employed by people who already have a diagnosis.

See MPEP § 806.05(d).

20          Inventions I and II vs. III are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another

and materially different process. (MPEP § 806.05(e)). In this case the method could be practiced by hand.

Because these inventions are distinct for the reasons given  
5 above and have acquired a separate status in the art because of  
their recognized divergent subject matter, restriction for  
examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to  
10 be complete must include an election of the invention to be  
examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims  
to a non-elected invention, the inventorship must be amended in  
15 compliance with 37 CFR 1.48(b) if one or more of the currently  
named inventors is no longer an inventor of at least one claim  
remaining in the application. Any amendment of inventorship must  
be accompanied by a petition under 37 CFR 1.48(b) and by the fee  
required under 37 CFR 1.17(i).

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This application contains claims directed to the following  
patentably distinct species of the claimed invention: Applicants  
are required to elect a single condition and a single enzyme each  
of which is specific, substantial and credible.

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Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claims are generic.

5       Applicant is advised that a response to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic  
10      is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37  
15      CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or  
20      identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of  
25      the other invention.

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Art Unit 1623

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ralph Gitomer whose telephone number is (703) 308-0732. The examiner can normally be reached on Tuesday-Friday from 8:00 am - 5:00 pm.

5 The examiner can also be reached on alternate Mondays. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Geist can be reached on (703) 308-1701. The fax phone number for this Art Unit is (703) 308-4556.

10 Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1234. For 24 hour access to patent application information 7 days per week, or for filing applications electronically, please visit our website at [www.uspto.gov](http://www.uspto.gov) and click on the button **Patent Electronic Business Center** for more information.

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